

REMARKS

Claims 1-56 are pending in the application. No new matter has been added as a result of the above amendments. Reconsideration and allowance of the pending claims is respectfully requested in light of the foregoing amendments and the following remarks.

Rejections Under 35 U.S.C. § 103

Claims 1, 3-4, 8, 10-11, 15, 17-18, 22, 24-25, 29, 31-32, 36, 38-39, 43, 45-46, 50, and 52-53 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,970,490 to Morganstern (hereinafter "Morganstern") in view of U.S. Patent Publication No. 2004/0024852 to Chen et al (hereinafter "Chen"). Claims 2, 9, 16, 23, 30, 37, 44, and 51 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Morganstern in view of Chen and further in view of U.S. Patent Publication No. 2002/0138733 to Ishibashi (hereinafter "Ishibashi"). Claims 5-7, 12-14, 19-21, 26-28, 33-35, 40-42, 47-49, and 54-56 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Morganstern in view of Chen and further in view of U.S. Patent No. 5,777,876 to Beauchesne (hereinafter "Beauchesne").

As the PTO recognizes in MPEP § 2142:

... The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness. . .

It is submitted that, in the present case, the Examiner has not factually supported a prima facie case of obviousness for the following, mutually exclusive, reasons.

1. Even when combined, the references do not teach the claimed subject matter.

The Morganstern and Chen references cannot be applied to reject independent claims 1, 8, 15, 22, 29, 36, 43, and 50 under 35 U.S.C. § 103(a) because, even when combined, the references do not produce the claimed subject matter.

Claim 1, as amended, recites in part:

a release mechanism . . . to receive a permission semaphore indicating that the data is synchronized among the plurality of databases and transfer the permission semaphore to the first database to authorize usage of the database.

Moreover, the Examiner points to paragraphs 0035-0036 of Chen as teaching "a release mechanism . . . to receive a permission semaphore indicating that the data is synchronized among the plurality of databases," as recited in claim 1 (emphasis added). In particular, in the "Response to

Arguments" section of the Office action, on page 7, the Examiner points to Chen's disclosure that "[t]he semaphores 210 allow them to coordinate their accesses to the database . . . so that, e.g., the name server component 22 is not trying to read a cached entry that the cache manager component 206 is updating." As previously stated, the use of semaphores as described by Chen is for the purposes of indicating availability of a resource, rather than indicating synchronization of data (as required by claim 1). This is clearly not the same as using a semaphore to indicate that data is synchronized; clearly, whether a resource (e.g., a database) is available has no bearing on whether data stored therein is synchronized with that of another database.

In the final Office action, the Examiner responded to Applicants' argument in this regard by observing that "one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references." Applicants concur with this observation; however, this is not a case in which a reference is attacked individually to show nonobviousness. In paragraph 7 of the Office action, the Examiner cites Chen alone as reading on the above-noted element. Implicit in the Examiner's reliance on Chen in this regard is the Examiner's conviction that Morganstern fails to teach the element; if that is not the case, it is incumbent on the Examiner to point to the teachings of Morganstern that read on the element. In summary, neither Morganstern, nor Chen, nor the combination thereof, teaches "a release mechanism . . . to receive a permission semaphore indicating that the data is synchronized among the plurality of databases" as recited in independent claim 1.

In view of the foregoing, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection of claim 1 under 35 U.S.C. §103 should be withdrawn. Claims 8, 15, 22, 29, 36, 43, and 50 include limitations similar to those of claim 1 and are therefore also deemed to be allowable for the reasons set forth in detail above with reference to claim 1. Claims 2-7, 9-14, 16-21, 23-28, 30-35, 37-42, 44-49, and 51-56 depend from and further limit independent claims 1, 8, 1, 22, 29, 36, 43, and 50 and are therefore also deemed to be allowable for the reasons set forth in detail above.

2. The combination of references is improper.

Assuming, *arguendo*, that when combined, the references teach the claimed subject matter (which is clearly not the case, as demonstrated above), there is another, mutually exclusive, and compelling reason why the Morganstern and Chen references cannot be applied to reject the claims under 35 U.S.C. §103.

§2142 of the MPEP also provides

[T]he examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made. . . . The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole.'

In this context, the MPEP further provides at §2143.01

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

Recently, the Supreme Court ruled that the longstanding "teaching, suggestion, or motivation (TSM) test" still applies, but should be used in a more "expansive and flexible" manner. *KSR Int'l. Co. v. Teleflex Inc.*, 550 U.S. __, 11 (2007). The Court stated that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." Id. at 14-15 (emphasis added).

In the present case, the Examiner has not expressed any valid reason why a person of ordinary skill in art would combine the integration platform for processing heterogeneous data, as taught by Morganstern, with a fiber channel network employing RSCNs with enhanced payload, as taught by Chen. In particular, the disclosure of Morganstern is focused on providing interoperability for heterogeneous databases; in contrast, the disclosure of Chen is focused on increasing the scalability of fiber channel networks through use of remote switch information caching, an improved name server structure, and an extended RSCN packet payload. Thus, it is clear that neither reference provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103 rejection.

The Examiner's counter-argument, set forth in section 16(a)(ii) of the final Office action, illustrates and provides support for Applicants' position that the Examiner's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to the independent claims. In particular, the Examiner states that, "while Morganstern fails to disclose a method of issuing semaphores, it would have been obvious to one of ordinary skill in the art to modify the invention as disclosed by Morgenstern by the invention disclosed by Chen" because Chen discloses the use of semaphores. To support his claim that the

combination would have been obvious, the Examiner points to Applicants' claimed invention, stating that "[i]n the present invention, semaphores are utilized to indicate whether data is synchronized among a plurality of databases." Clearly, the Examiner is using Applicants' claimed invention as a roadmap to piece together an obviousness rejection. Moreover, were this technique proper, it would be impossible to imagine a situation in which an obviousness rejection could not be crafted.

In the present case it is clear that the Examiner's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference or in the state of the art at the time the invention was made for the combination as applied to the independent claims. Therefore, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness with regard to independent claims 1, 8, 15, 22, 29, 36, 43, and 50, as well as all claims dependent therefrom, has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

Conclusion

For at least the reasons set forth in detail above, independent claims 1, 8, 15, 22, 29, 36, 43, and 50 are deemed to be in condition for allowance. Claims 2-7, 9-14, 16-21, 23-28, 30-35, 37-42, 44-49, and 51-56 depend from and further limit independent claims 1, 8, 1, 22, 29, 36, 43, and 50 and are therefore also deemed to be in condition for allowance. Accordingly, Applicants respectfully request that the Examiner withdraw the pending rejections and issue a formal notice of allowance.

An early formal notice of allowance of claims 1-56 is respectfully requested.

Respectfully submitted,



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